

REMARKS

Claims 1-8, 10-26 are currently pending in this application. The Election/Restriction Requirement mailed August 16, 2006, requested restriction of the claims. As explained below, the undersigned requests reconsideration and withdrawal of the Election/Restriction.

With the exception of one claim, all of the claims that are currently pending in the case have already been examined. Indeed, some of the claims have been examined on multiple occasions. The Applicants respectfully submit that the fact that the claims have already been searched and examined together shows that there is no serious burden in continuing to examine them together, and, accordingly, withdrawal of the restriction requirement is respectfully requested. *See* MPEP § 808 (The Office Action must explain “the reasons why there would be a serious burden on the examiner if restriction is not required.”).

There have been twenty-two or more claims pending in the application since its initial filing date nearly three years ago.¹ Since then, there have been three Office Actions or Advisory Actions. In each, the pending claims have been examined and considered, and multiple searches have been conducted. Now, in response to Applicants’ filing of an RCE, which amended only one claim, narrowing the scope of general subject matter that has been pending for nearly three years, the current Office Action seeks to impose a restriction/election requirement, asserting for the first time that, without restriction, a serious burden is imposed on the Examiner because “the inventions require a different field of search.” For the reasons stated below, the Applicants respectfully traverse the restriction/election requirement.

¹ Prosecution Chronology - This application was originally filed on October 28, 2003 with twenty-two claims. The first Office Action of August 30, 2005, examined and rejected all twenty-two claims. Some of these claims were amended, one was canceled, and new dependent claims 23-26 were added in the Applicants’ November 11, 2005, response. All pending claims 1-8 and 10-26 were re-examined in the next Office action, mailed February 7, 2006, which was made final. Applicants filed a Response to the Final Office Action on May 2, 2006. All pending claims were again re-examined a third time in the Advisory Action, mailed May 23, 2006. An RCE and amendment, which amended only one claim, were filed on June 7, 2006. An Election/Restriction was mailed August 16, 2006, in response.

The Restriction Requirement Between Groups I & II and Group III Is Improper

The Election/Restriction Office Action states that restriction is required to one of either the process (I & II) or apparatus (III) claims. *See* Office Action, p. 2 (“Inventions I & II and Invention III are related as process and apparatus for its practice.”). The claim groupings were identified as follows:

- I. Claims 1-7 and 10-12, laser methods comprising target removal amount.
- II. Claims 8 and 23-26, laser treatment of a stent.
- III. Claims 13-22, laser apparatus.

See Office Action, p. 2. The MPEP requires that the Office Action explain “the reasons why there would be a serious burden on the examiner if restriction is not required.” *See* MPEP § 808. To satisfy this burden, the Office Action states that the inventions “require a different field of search (see MPEP § 808.02).” *See* Office Action, p. 2.

Applicants respectfully traverse this restriction requirement and respectfully request withdrawal thereof, because at least the inventions of group I & II, on the one hand, and group III on the other, as identified by the Examiner, are sufficiently related, and examination of these inventions together does not create a serious burden on the Examiner. “If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct invention.” MPEP §803 (emphasis added).

Here, the subject matter of each of the pending claims has already been searched multiple times. In fact, in the last search conducted in concert with the Final Office Action, the exact same four references were cited in rejecting claims 8 and 13-26, and those claims cover both apparatus and method claims in groups II and III, which span across this Office Action’s restriction requirement. Thus, those method and apparatus claims were previously searched and examined together without any serious burden. Where “there is no clear indication of separate future classifications and fields of search, no reasons exist for dividing among inventions.” *See* MPEP § 808.02. No previous Office Actions have ever expressed any undue burden as well. Further, since those claims were not amended in the Response filed with the RCE, there can be no credible argument that a serious burden now exists between the method and apparatus claims.

The general subject matter of the method claims in group I has likewise already been examined, considered and searched multiple times. Although the Applicants' last Response and RCE amended one independent claim in group I, the Applicants submit that the subject matter of the amendment entered in that Response must also have been searched during the previous three examinations of the claims. Because the untimely requirement for a restriction follows several Office actions on the merits, there is no basis for requiring withdrawal of any claims.

For at least these reasons, a co-extensive search could be carried out without a serious burden, as previous Office Actions have done. As such, Applicants respectfully request reconsideration and withdrawal of the restriction.

The Election/Restriction Requirement Between Group I and Group II Is Improper

The Election/Restriction Office Action also states that the "application contains claims to the following patentably distinct species:

- I. Claims 1-7 and 10-12, laser target amount removal on a device.
- II. Claims 8 and 23-26, laser treatment of a stent.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species." *See* Office Action, p. 2. The Office Action continues, stating that there are no generic claims between the two species. *Id.*

Applicants traverse this restriction/election requirement as the Office action lacks the required explanations to justify its untimely restriction. "Every requirement to restrict has two aspects: (A) the reasons (as distinguished from the mere statement of conclusion) why each invention as claimed is either independent or distinct from the other; and (B) the reasons why there would be a serious burden on the examiner if restriction is not required." *See* MPEP § 808. Here, the Election/Restriction Office Action has neither provided any reason or explanation of (1) why the claims in group I and II are independent or distinct, nor (2) why non-restriction imposes a serious burden. Rather, the only explanation offered is that group I and II are species. This does not satisfy the Examiner's burden. *See* MPEP § 803 (a mere statement of conclusion is inadequate); *see also* MPEP § 808.02.

First, the Office Action fails to provide reasons as to why the claims in group I and II are independent or distinct. In the citation to page 2 of the Office Action above, the Examiner used form paragraph ¶ 8.01. *See* MPEP § 809.02(a), Form ¶ 8.01. However, in doing so, the Examiner omitted the following intervening sentence from Form ¶ 8.01: “The species are independent or distinct because [2].” *Id.* The MPEP requires that the Examiner “[i]n bracket 2, explain why the inventions are independent or distinct.” *Id.* Here, the Office Action’s omission shows that it has failed to provide any such reasons, and thus, has failed to meet its initial burden to justify restriction.²

Second, as explained above in the preceding section, the Office Action fails to provide reasons as to why non-restriction imposes a serious burden. This requested election/restriction has come deep into the prosecution of the case, years after the subject matter of the claims was first presented, and well after the first Office action of August 30, 2005. Because the requirement for an election is untimely and follows several Office actions on the merits, there is no basis for requiring withdrawal of any claims.

Nevertheless, to satisfy Applicants’ duty to respond, the undersigned hereby elects, with traverse, Group III as identified by the Examiner, claims 13-22, drawn to a laser apparatus. This election is without prejudice to or disclaimer of the non-elected claims. Applicants reserve the right to file one or more divisional application(s) directed to the non-elected subject matter in accordance with the provisions of 35 U.S.C. § 121.

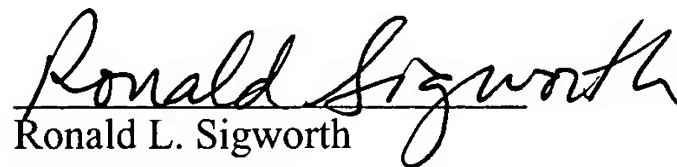
² The Office Action characterizes group I claims 1-7 and 10-12 as a species for “laser target amount removal on a device;” however, the claims in group II regard a “method for removal of a selected portion of a therapeutic coating” by “ablating the selected portion ... with a laser.” Likewise, the Office Action characterizes group II claims 8 and 23-26 as a “laser treatment of a stent” species; however, the claims in group I regard “ablating ... coating from the rotating medical device ... with the laser,” and “wherein the medical device is a stent.” *See* Claims 1 & 7.

The Commissioner is hereby authorized to charge Kenyon & Kenyon Deposit Account No. 11-0600 for any applicable fee.

Should there be any questions concerning this matter, the Examiner is invited to contact the Applicant's undersigned attorney.

Respectfully submitted,

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